

REMARKS

In the application claims 1-14, 29-40, 43, and 44 remain pending. Claims 15-28, 41, and 42 have been canceled without prejudice.

No claims presently stand allowed. The reconsideration of the rejection of the claims is, however, respectfully requested.

The pending claims presently stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily in view of the combination of Kamon (U.S. Patent No. 5,726,645) and Ivie (U.S. Patent No. 5,815,086). In rejecting the claims, it was set forth that Kamon discloses a remote control system having a detecting circuit associated with an appliance wherein the detecting circuit has circuitry for determining a state of an appliance and for transmitting to a remote control a signal for use in configuring the remote control. While it was acknowledged that Kamon fails to disclose a device for monitoring power supplied to an appliance, Kamon instead disclosing detection circuitry which monitors an appliance head phone jack, it was set forth that Ivie discloses a remote control system comprising a universal transmitter associated with an appliance which includes a power monitor for monitoring power supplied to the appliance to determine the state of the appliance and a wireless transmitter (which it is to be noted is used to communicate with nothing more than the appliance) as well as a hand-held remote controller (230) having a library of command codes. Thus, the Office Action concluded that it would have been obvious to modify Kamon's detecting circuitry as taught by Ivie for the reason that a current monitor effectively determines whether an appliance is in a "power on" state or a "power off" state and enables the headphone plug of Kamon's appliance to be free for its intended use instead of being used as a power monitor.

In response to this rejection it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that a combination of references being relied upon disclose the claimed invention

“as a whole.” This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. In other words, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Considering now the references cited, while Ivie may disclose the element of a device for monitoring power supplied to an appliance to determine the current state of an appliance, it is respectfully submitted that Ivie nevertheless fails to provide any suggestion or motivation to modify Kamon to arrive at the system claimed. In this regard, nothing from Ivie discloses, teaches, or suggests that it would be desirable to modify the system of Kamon to enable the headphone plug of Kamon’s appliance to be free for its intended use instead of being used as a power monitor as asserted in the Office Action. Accordingly, it is submitted that the determination of obviousness set forth in the Office Action, which relies upon a motivation that finds no basis in the cited references, reflects the impermissible use of hindsight and, for at least this reason, the rejection of the claims must be withdrawn.

It is additionally submitted that it is impermissible to pick and choose from a reference only that which will support a determination of obviousness while disregarding what a reference

teaches in its entirety. As concerns Ivie, while Ivie may disclose the use of a device that monitors power supplied to an appliance to thereby determine the state of an appliance, Ivie does not disclose, teach, or suggest the desirability of using the state of an appliance for the purpose of configuring a remote control device. Ivie only suggests the desirability of using the state of an appliance to determine whether or not a command should be transmitted to an appliance.

Furthermore, when Ivie is considered in its entirety, Ivie teaches directly against a system having a hand-held remote control that is configurable. In this regard, Ivie teaches the desirability of having a hand-held remote control (230) that always transmits the same commands when it is desired to control operations of a given type of appliance, e.g., the remote control transmits the same numeric infrared codes to control a television without regard to the make or model of the television (Col. 11, line 49-Col. 12, line 29). Thus, were one to follow the teachings of Ivie *when Ivie is considered in its entirety*, instead of arriving at the invention claimed one would be led to modify Kamon by replacing the hand-held remote controller (1) of Kamon with the non-configurable, hand-held remote controller (230) of Ivie to arrive at a system in which a hand-held remote controller is designed to transmit predefined command codes to an intermediate system to thereby cause the intermediate system to use its wireless transmitter to control operations of the appliance. Since such a system clearly fails to include each and every element of the claims, it is respectfully submitted that a modification of Kamon in view of the teachings of Ivie cannot be said to present a *prima facie* case of obviousness. For at least this reason it is respectfully submitted that the rejection of the claims must be withdrawn.

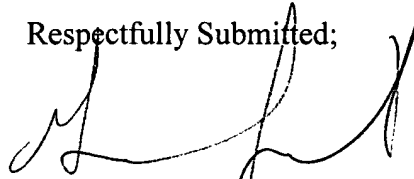
CONCLUSION

It is respectfully submitted that the cited references, whether considered alone or in combination, fail to disclose, teach, or suggest each and every element set forth in the pending claims. For at least this reason it is submitted that the application is in good and proper form for

allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

A handwritten signature in black ink, appearing to read 'G. Jarosik', written over the printed name.

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